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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,778	08/11/2000	Jay M. Short	DIVER1280-4	9253

7590 10/22/2002  
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EXAMINER

LOEB, BRONWEN

ART UNIT PAPER NUMBER

1636

DATE MAILED: 10/22/2002 44

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/636,778

Applicant(s)

SHORT ET AL.

Examiner

Bronwen M. Loeb

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2001.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-55, 57-71 and 74-155 is/are pending in the application.
- 4a) Of the above claim(s) 1-53 and 74-155 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54, 55 and 57-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: Copy of Papers Originally Filed information.

### **DETAILED ACTION**

This action is in response to the amendment filed 15 October 2001 in which claims 54-60, 63, 67 and 70 were amended, claims 72 and 73 were cancelled and new claims 123-155 were presented and the amendment filed 10 July 2002 in which claim 54 was amended.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-55, 57-71 and 74-155 are pending.

### ***Election/Restrictions***

1. Applicant's election of Group II in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 1-53 and 74-122 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.
3. New claims 123-155 are drawn to a method for identifying nucleic acid for target DNA sequences, classified in class 435, subclass 4. These claims are not drawn to the elected method, which is a method of screening for an agent that modulates the activity of a target cell component. These claims are therefore also withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

***Drawings***

4. The drawings are objected to because Figures 12-17 are partially obscured by the hole-punches in the top margins of the pages. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

This objection is maintained as Applicant has not clearly addressed it in either the amendment filed 16 October 2001 or that filed 10 July 2002.

***Response to Amendment***

5. The rejection of claims 54-71 under 35 U.S.C. §112, second paragraph has been withdrawn in view of Applicant's amendment filed 16 October 2001.

The rejection of claims 54, 55, 58, 59 62, 63, 67 and 69 stand rejected under 35 U.S.C. §102(e) as being anticipated by Stover et al has been withdrawn in view of Applicant's amendment filed 10 July 2002.

The rejection of claims 54, 55, 58, 59, 62, 63, 67, 68 and 69 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Stover et al. in view of Valdivia et al, and Trias et al has been withdrawn in view of Applicant's amendment filed 10 July 2002.

The rejection of claims 54, 55, 58, 59, 60, 61, 62, 63, 67 and 69 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver ('968), in view of Weaver ('060), Trias et al and Rather et al has been withdrawn in view of Applicant's amendment filed 10 July 2002.

6. New grounds of rejection are presented below.

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**New Grounds of Rejection**

***Claim Rejections - 35 USC § 112***

7. Claims 54, 55, 57-71 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 54 is vague and indefinite as it is unclear what the nexus is between the recited detectable marker and the rest of the claim. Does it play a role in detecting the effect of a molecule on the activity of the target cell component?

Claim 54 recite the limitation "the cell component" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 69 recites the limitations "the fluorescent dye" and "a visible dye" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 70 recites the limitation "the target cell component" in line 1. There is insufficient antecedent basis for this limitation in the claim. This rejection would be overcome by amending the claim to recite "the target cell component".

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. §102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. §122(b). Therefore, this application is examined under 35 U.S.C. §102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. §102(e)).

9. Claims 54, 55, 58-63 and 67-69 are rejected under 35 U.S.C. §102(e) as being anticipated by Thompson et al (USP 5,824,485). Thompson et al teach assaying for molecules produced by a gene expression library by co-encapsulating the molecule and a cell with a target cell component, such as a particular enzymatic substrate or a reporter gene construct whose expression may be influenced by a molecule derived from the gene expression library (eg. a chemoresponsive reporter construct which may respond positively or negatively). The detectable marker may be a bioluminescent molecule (eg. green fluorescent protein), a chemiluminescent molecule or an enzymatic substrate. Detection may be carried out using FACS. See entire document, especially Figure 8, col. 4, lines 8-29, col. 5, lines 39-65, col. 32, line 60-col. 36, line 57, col. 48, line 55-col. 49, line 30 and col. 50, lines 20-44.

### **Conclusion**

Claims 54, 55, 57-71 are rejected.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices

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published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bronwen M. Loeb whose telephone number is (703) 605-1197. The examiner can normally be reached on Monday through Friday, from 10:00 AM to 6:30 PM. A phone message left at this number will be responded to as soon as possible (usually no later than the next business day after receipt by the examiner).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, can be reached on (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to Tracey Johnson, Patent Analyst whose telephone number is (703) 305-2982.

Customer service for Tech Center 1600 may be reached at (703)-308-0198.

Bronwen M. Loeb, Ph.D.  
Patent Examiner  
Art Unit 1636

October 18, 2002



JAMES KETTER  
PRIMARY EXAMINER